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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,216	05/04/2001	Jan Nevermann	H&U104	1455

7590

07/16/2003

Marlana Titus
Nash & Titus
7 Marcus Court
Rockville, MD 20850

EXAMINER

BAHAR, MOJDEH

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 07/16/2003

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/831,216

Applicant(s)

NEVERMANN ET AL.

Examiner

Mojdeh Bahar

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-- **Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --**
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 28, 2003 has been entered.

Claims 11-22 are herein examined on the merits.

Applicant's remarks have overcome the rejection under 35 USC 112 in the final office action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admissions regarding the prior art in the specification in view of Moberg (WO 96/11572).

On page 4 of the specification, applicants disclose that two German patents (DE OS 3227126 and 3229097) teach that certain combinations of anionic surfactants, aliphatic and aromatic carboxylic acids as well as a few heteroatomic acids are capable of killing off viruses, bacteria and fungi.

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Applicant's admissions regarding the prior art on page 4 of the specification, do not teach the employment of triglycols in its combination composition capable of killing off viruses, bacteria and fungi. Applicant's admissions also do not teach specific aromatic or aliphatic carboxylic acids to be employed in its combination composition. Further, applicant's admissions do not teach a method of combatting microorganisms employing its combination composition.

Moberg teaches an antimicrobial/disinfectant composition comprising carboxylic acids such as propionic acid, hydroxypropionic acid, see particularly claim 4. Moberg further teaches the employment of propylene glycol and butylene glycol in its composition, see particularly claim 3. Moberg further teaches a method of combating microorganisms employing carboxylic acids and diols, see particularly claim 12.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a diol (e.g. propylene glycol) in the combination composition restated by the applicant on page 4 of the specification. It would have also been obvious to employ the claimed carboxylic acids and diols in a method of combating pathogenic organisms.

One of ordinary skill in the art would have been motivated to employ diol (e.g. propylene glycol) in the combination composition restated by the applicant on page 4 of the specification because diol are known to be useful in antimicrobial compositions. It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be useful for the very same purpose, *In re Kerkhoven*, 205 USPQ 1069, 1072 (CCPA 1980). Moreover, the employment of two agents known to be useful in a method of combating microorganisms would be reasonably expected to

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be useful in combating pathogenic microorganisms regardless of the host. The two agents, singly or in combination, would be expected to exhibit antipathogenic activities, regardless of its cause, absent evidence to the contrary. No such evidence is seen.

Response to Arguments

Applicant first argues that all the prior art references are said to be useful against human or zoological pathogens, whereas the claimed composition herein has a high degree of effectiveness against phytopathogens. Note that claims 11-21, are all drawn to a **composition** and the recitation of **intended use (i.e., the fact that the composition is a phytopathogenic composition and/or that is employed in combating pathogens), in a claim drawn to a composition does not further limit the claim.** As to claim 22, the only claim drawn to a method, the prior art references meet all the claimed limitations because two agents known to be useful in a method of combating microorganisms would be reasonably expected to be useful in combating pathogenic microorganisms regardless of the host. The two agents, singly or in combination, would be expected to exhibit antipathogenic activities, regardless of its cause. Applicant argues that the problem to be solved by the instant invention is not the additive effects of the components (as argued by the examiner for the motivation to combine the references in the previous office actions), but the tolerance of plant of the instant composition. In response to applicant's argument that the problem to be solved by the instant invention is tolerability of plants and not cumulative or additive results of the combination of ingredients, the fact that applicant has recognized another advantage which would flow naturally from following the

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suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

As pointed out in the advisory action of December 27, 2002, the declaration submitted under 37 CFR 1.132 is not persuasive to remove the obviousness rejection herein. Applicant argues that the tested specie of Venno-Cycla 2 does fall within the first claim of DE 3229097. Applicant further argues that the difference between the prior art claims and the tested composition is the employment of lactic acid in lieu of tartaric acid. Note that lactic acid has one hydroxyl substituent while tartaric acid has two hydroxyl substituents. Assuming *arguendo* that tartaric and lactic acids are equivalents as argued by the applicant, Venno-Cycla 2 is only one of the many combinations that fall within the genus described in claim 1 of the prior art. Note that unexpected results need to be demonstrated over prior art in a manner that is clear, convincing and commensurate in scope with the claims. The showing need to show clearly and convincingly, e.g., by testing at least some of the prior art examples against the examples 1-5 in the specification. Furthermore the showing by the 132 affidavit is not commensurate in scope with the claims. Therefore the obviousness rejection is maintained.

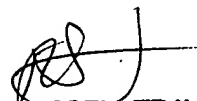
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mojdeh Bahar whose telephone number is (703) 305-1007. The examiner can normally be reached on (703) 305-1007 on Monday, Tuesday, Thursday and Friday from 8:30 a.m. to 6:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan., can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Mojdeh Bahar
Patent Examiner
July 12, 2003



RUSSELL TRAVERS
PRIMARY EXAMINER